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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/036,266

12/24/2001

Nicolas Kourim

594P

4274

7590

12/20/2005

Thomas M. Freiburger
25th Floor
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San Francisco, CA 94108

EXAMINER

DESHPANDE, KALYAN K

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,266

Applicant(s)

KOURIM ET AL.

Examiner

Kalyan K. Deshpande

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>March 17, 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The following is a non-final office action in response to the communications received on December 24, 2001. Claims 1-6 are now pending in this application.

Information Disclosure Statement

2. The examiner has reviewed the patents and articles supplied in the Information Disclosure Statements (IDS) provided on March 17, 2003.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The abstract of the disclosure is objected to because the abstract exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

4. Claim 4 is objected to because of the following informalities: the term "an" should be "and". Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is required to produce a useful, concrete, and tangible real-world result. An invention that fails to produce a tangible result is one that involves no more than the manipulation of an abstract idea. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). In order to be concrete the result must be substantially repeatable or the process must substantially produce the same result again.

Claim 1 merely recites the manipulation of an abstract idea and do not produce a concrete result. Claim 1 recites "identifying at least one critical business process", which is a mere abstract idea that does not produce real-world results. The step of "identifying at least one critical business process" is based on subjective standards. The results of this step will not produce concrete real-world results since there is no evidence that this step, when repeated, will produce substantially the same result. This step is based on a subjective standard and will produce different results for each individual performing the step. Because the results produced by the method are not tangible and concrete, claim 1 is considered to be directed toward non-statutory subject matter.

Claims 2-6 recite subject matter already addressed by the rejection of claim 1; therefore the same rejection applies to these claims.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Main et al. (U.S. Patent No. 5893905).

As per claim 1, Main teaches:

A method for monitoring, analyzing, and improving information systems as they affect the functioning of business processes for a concern dependent on information systems, comprising:

reviewing business processes and identifying at least one critical business process of the concern (see column 1 lines 48-62, column 1 lines 65-67, and column 2 lines 1-57; where jobs necessary for the monitoring job execution are assessed. These processes are manual performed and the reference invention automates these processes.),

identifying elements and relationships of elements of existing information systems structure that support or affect each identified critical business process (see column 1 lines 65-67, column 2 lines 1-6, and column 3 lines 27-34; where

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identified discrepancies in jobs is analyzed to determine their impacts on other jobs in the job stream.),

deploying equipment including necessary software both on and off the client concern's site as needed to collect and monitor data from said identified information systems elements and connecting the on-site equipment including an on-site server to the concern's information systems structure (see column 4 lines 15-49; where data is collected by a data collection software on the production server and the production server runs business processes.),

setting parameters as to what data and the manner in which data will be collected from said identified elements, collecting data from pre-identified points comprising said identified elements in the information systems structure, then transferring the collected data from the on-site server to an off-site data warehouse included in the off-site equipment (see column 4 lines 50-57, column 5 lines 9-27, and column 6 lines 5-12; where a maintenance workstation allows a user to set the service level agreements parameters, including pre-identified start and stop times and job name. Data from the production server can be transferred to another server for redundancy.),

using the data warehouse, processing received data in accordance with preselected metrics to create metadata regarding the client concern (see column 5 lines 5-57; where the data collection software collects information job performance data, including job processing exceptions, error codes,

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terminations, job names, start time, end time and completion status. Metadata is information relating to the who, where, and when of a transaction.),

rendering the data, formatted in a preselected manner for the concern and forwarding the rendered data to the concern (see column 4 lines 59-65, column 9 lines 13-67, and column 10 lines 1-32; where the data is presented to the user in a pre-determined fashion.), and

delivering reports to the client concern as to performance of the monitored information elements and the affected business processes, including recommendations for improving the information systems structure and its performance (see column 4 lines 59-65, column 9 lines 13-67, and column 10 lines 1-32; where the data is presented to the user in a pre-determined fashion. The data is analyzed to allow the user to determine whether a job is having a problem and all of the other jobs affected by the job having a problem.).

As per claim 2, Main teaches:

The method of claim 1, wherein the rendered data is arranged in such a way as to be of interest to different management personnel in the client concern, and including assigning each different management individual a unique login and password so as to be able to access the rendered data via a wired or wireless network (see column 4 lines 59-67, column 5 lines 1-8, column 9 lines 13-67, and column 10 lines 1-32; where management personnel log in to the system with a unique login id and password. The maintenance workstation, client workstation, and production server are all connected via a local area network. The information

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presented to management personnel is of interest such that it presents personnel information regarding to job processing performance.);.

As per claim 4, Main teaches:

The method of claim 1, wherein the collected and processed data from the client concern are compared to data taken from other or previous clients in similar businesses for the purpose of determining relative efficiency levels of processes and elements in the client concern (see column 2 lines 39-48, column 7 lines 45-67, and column 8 lines 1-4; where current data is compared to that of previous executions to determine whether job performance efficiency is appropriate.).

As per claim 5, Main teaches:

The method of claim 1, further including following the collection and processing of the data, evaluating existing service level agreements and service level objectives of the client concern to determine whether the client concern is receiving service levels from third party providers as required by such agreements and objectives (see column 3 lines 26-44, column 8 lines 45-67, column 9 lines 1-13; where actual performance is compared to those in the service level agreements. If performance is not at the desired level, management personnel are alerted.).

As per claim 6, Main teaches:

The method of claim 1, further including the step of analyzing the collected data to determine an optimum service level agreement for a particular third party provider of services, in the event no such service level agreement is existing (see column 9 lines 13-29, column 9 lines 64-67, and column 10 lines 1-32; where a user has

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access to production data with an authorized user id and password. The user can also edit or create SLAs through the client workstation.).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Main et al. (U.S. Patent No. 5893905).

As per claim 3, Main teaches:

The method of claim 1, wherein the method includes deployment of equipment, software, and identification of data to be collected (see column 4 lines 15-57, column 5 lines 9-27, and column 6 lines 5-12; where hardware and software is used to monitor data. The user has the ability to set the parameters on the software to determine which data to collect and monitor.).

Main fails to teach:

prior to deploying the equipment on the client concern's site, presenting to the client concern a proposal as to deployment of equipment and software and identification of what data will be collected and monitored.

It is old and well-known in the art to submit a proposal containing an offer of products or to perform services for a client and for the proposal to contain detailed information regarding the offered products or services, such as the equipment, software,

and what the software will do. It is also old and well-known in the art to submit a proposal prior to performing services or providing products. The advantage of submitting a proposal to a client is that a proposal allows a client to thoroughly review, in writing, the extent of the offered products or services and gives the client the ability to accept the proposal. The advantage of submitting a proposal prior to commencing performance is that it serves notice to both parties as to the extent of the offered products or services. It would have been obvious, at the time of the invention, for one of ordinary skill in the art to submit a proposal containing detailed information on the offered products or services to a client in order to enable the client to review the proposal and accept the offer and thereby giving both parties notice as to the extent of the offered products or services.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following are pertinent to the current invention, though not relied upon:

Janovski et al. (U.S. Patent No. 5726914) teaches a system and method for collecting and storing data on performance analysis.

Powers et al. (U.S. Patent No. 5684964) teaches a system and method for generating performance data to determine the efficiency of an organization.

Foley (U.S. Patent No. 5956692) teaches a method and apparatus for monitoring physical processes.

Elnozahy et al. (U.S Patent No. 6792459) teaches a method for verifying performance of service level agreements.

Lewis et al. (Lewis, Lundy; Pradeep, Ray; "Service Level Management: Definition, Architecture, and Research Challenges", Global Telecommunications Conference, 1999, pp. 1974-1978) teaches a method to evaluate service level agreement proposals.

Park et al. (Park, Jong-Tae; Baek, Jong-Wook; "Management of Service Level Agreements for Multimedia Internet Service Using a Utility Model", *IEEE Communications Magazine*, May 2001, pp. 100-106) teaches a method for managing and controlling service level agreements for multimedia Internet services.

Larson (Larson, Kent D.; "The Role of Service Level Agreements in IT Service Delivery", *Information Management & Computer Security*, 1998, pp. 128) teaches recognizing business processes and developing service level agreements for the performance of these processes.

Mier et al. (Mier, Edwin E.; Percy, Kenneth M.; "Measuring SLA Compliance (Software Review)", *Business Communications Review*, May 2001) teaches of existing SLA monitoring software and the features and benefits of each software system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalyan K. Deshpande whose telephone number is (571) 272-5880. The examiner can normally be reached on M-F 8am-5pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KKD

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